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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,339

09/30/2003

Mickey L. Peshoff

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07/25/2006

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EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,339

Applicant(s)

PESHOFF, MICKEY L.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-9 and 15-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,7-9 and 15-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This Office action is in response to applicant's amendments and remarks of 5/9/2006. Claims 1, 7-9 and 15-17 are pending in this application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7-9 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) The newly amended claims are now very confusing. Note the following:

an effective amount of a mixture of fat soluble vitamins A, ~~and D, and E~~ selected
from the group consisting of retinol, 3,4-didehydroretinol, carotene, alpha-carotene, beta-
carotene, delta-carotene, gamma carotene, cholecalciferol, ergocalciferol, Vitamin E
acetate, Vitamin E succinate, pharmaceutically acceptable Vitamin E salts and Vitamin E
phosphate.

The claim structure is "a mixture ... selected from the group consisting of retinol"

This structure can immediately be seen as being indefinite because a mixture selected from the group consisting of must recite members that are mixtures. Here, applicant only lists individual components, not mixtures.

(2) Dependent claims 7-9 are now duplicative of the amended independent claim 1. Unless there is some additional confusing interpretation associated with claim 1, as

noted above, all of the species in claims 7-9 have already been incorporated into claim 1.

(3) Claim 15 recites retinyl palmitate as the vitamin A of claim 1. However, claim 1 has already limited the vitamin A species in its Markush grouping, which does not include retinyl palmitate. The Markush structure noted above is indefinite and claim 15 further adds to the indefiniteness.

(4) Claim 17 depends on the now-canceled claim 2. Applicant is advised that claim 17 will therefore not be further examined on the merits.

Claims 7-9 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

(1) Claims 7-9 fail to further limit the base claim, i.e. claim 1. All of the specific vitamins in claims 7-9 are already and exclusively recited in claim 1.

(2) Claim 15 recites a vitamin A that is not possible from the Markush language of claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7-9 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (US 4,857,321).

Thomas explicitly discloses an ointment composition that contains retinol palmitate (ingredient p in claims 1-2), cholecalciferol (ingredient x in claim 1 & ingredient w in claim 2), tocopherol acetate (ingredient v in claims 1-2), and a mixture of vitamins A and D₃ (ingredient w in claims 1-2).

It is noted that vitamin A is retinol (i.e. alternative name for same substance), retinol palmitate is retinyl palmitate, vitamin E is tocopherol, vitamin E acetate is tocopheryl acetate, and vitamin D₃ is cholecalciferol. Therefore, even though Thomas does not use the same exact terminology as applicant's claims, the same exact substance is contained in Thomas' composition. The claims are thereby anticipated.

Applicant's remarks relative hereto have been given due consideration but they were deemed unpersuasive. Applicant argues that only certain members of the vitamin family are disclosed in the cited reference, i.e. not all elements are listed in the now

amended claim 1. However, the discussion above clearly shows that applicant is mistaken. Vitamins have many different names for the same exact substance. Thomas' Vitamin A and applicant's retinol are one and the same. Thomas' Retinol palmitate and applicant's retinyl palmitate are one and the same. Thomas' Tocopheryl acetate and applicant's vitamin E acetate are one and the same. Thomas' vitamin D3 and applicant's cholecalciferol are one and the same. The claims are thereby anticipated.

Claims 1, 8-9 and 15-16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Derwent abstract 2000-617480 (abstracting RU 2146921).

Derwent abstract 2000-617480 explicitly discloses a composition for dermatological diseases, which contains retinol palmitate, tocopherol acetate, and ergocalciferol.

Since claim 15 depends on claim 1, claim 1 is being treated here as if it somehow encompasses retinyl palmitate as vitamin A. A claim drafting error in not including retinyl palmitate in the Markush grouping of claim 1 is assumed herein. Indefiniteness and improper dependency issues regarding claim 15 have been discussed earlier in this Office action.

As noted above, retinol palmitate is the same substance as retinyl palmitate and tocopherol acetate is alternative terminology for vitamin E acetate. The claims are thereby anticipated.

Applicant's remarks relative hereto have been given due consideration but they were deemed unpersuasive. Applicant argues that only certain members of the vitamin family are disclosed in the cited reference, i.e. not all elements are listed in the now amended claim 1. However, the discussion above clearly shows that applicant is mistaken. Vitamins have many different names for the same exact substance. The disclosed tocopheryl acetate and applicant's vitamin E acetate are one and the same. The claims are thereby anticipated.

Claims 1, 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Redlinger (US 6,146,650).

Redlinger explicitly discloses a dermatological composition that contains vitamin A (i.e. retinol), vitamin D3 (i.e. cholecalciferol) and tocopheryl acetate (i.e. vitamin E acetate). The claims are thereby anticipated.

It is noted that this new ground of rejection addresses applicant's claim amendments of 5/9/2006, which for the first time required a specific combination of retinol, cholecalciferol and vitamin E acetate in a single claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK
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